

**UNITED STATES PATENT AND TRADEMARK OFFICE**

**SERIAL NO:** 79/021358

**MARK:** TRUWELD

**CORRESPONDENT ADDRESS:**

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**GENERAL TRADEMARK INFORMATION:**

<http://www.uspto.gov/main/trademarks.htm>

**TTAB INFORMATION:**

<http://www.uspto.gov/web/offices/dcom/ttab/index.html>

**APPLICANT:** TRUMPF GmbH + Co.  
KG

**CORRESPONDENT'S  
REFERENCE/DOCKET NO:**

N/A

**CORRESPONDENT E-MAIL ADDRESS:**

**EXAMINING ATTORNEY'S APPEAL BRIEF**

Applicant TRUMPF GmbH + Co. KG has appealed the Trademark Examining Attorney's final refusal to register the trademark TRUWELD for "industrial machine tools for welding workpieces using a laser beam" in International Class 7 and "lasers, not for medical purposes, in particular for the welding and treatment of workpieces" in International Class 9. Registration was refused under Trademark Act Section 2(d), 15 U.S.C. §1052(d) because of likelihood of confusion with the mark in U.S. Registration No. 0734796.

**FACTS**

On October 25, 2005, applicant TRUMPF GmbH + Co. KG filed a Section 66(a) application to register TRUWELD on the Principal Register for goods and services in International Classes 7, 9, 37, 40 and 42. In the first action mailed on May 3, 2006, the examining attorney refused registration under Trademark Act Section 2(d) because of likelihood of confusion with the mark TRU-WELD in U.S. Registration No. 0734796 used in connection with "fastening devices including welding studs and shear connectors." Applicant was also required to submit an acceptable identification of goods and services. Applicant requested a division of the original application on November 2, 2006. The division was granted and completed on December 7, 2006, and maintained in the present application the goods in International Classes 7 and 9. Applicant argued against the refusal under Section 2(d) and submitted an

amended identification of goods by response dated November 2, 2006. This appeal follows the examining attorney's final office action continuing the Section 2(d) refusal and subsequent denial of a request for reconsideration.

### ISSUE ON APPEAL

The only issue on appeal is whether there is a likelihood of confusion of the proposed mark TRUWELD with the mark in U.S. Registration No. 0734796.

### ARGUMENT

**THE MARKS OF THE APPLICANT AND REGISTRANT ARE CONFUSINGLY SIMILAR IN APPEARANCE, SOUND, AND COMMERCIAL IMPRESSION AND THE RESPECTIVE GOODS ARE CLOSELY RELATED SUCH THAT THERE EXISTS A LIKELIHOOD OF CONFUSION, MISTAKE OR DECEPTION UNDER SECTION 2(d) OF THE TRADEMARK ACT.**

Trademark Act Section 2(d) bars registration where an applied-for mark so resembles a registered mark that it is likely, when applied to the goods or services, to cause confusion, mistake or to deceive the potential consumer as to the source of the goods and/or services. The Court in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973), listed the principal factors to consider in determining whether there is a likelihood of confusion. Among these factors are the similarity of the marks as to appearance, sound, meaning and commercial impression, and the relatedness of the goods or services. The overriding concern is to prevent buyer confusion as to the source of the goods or services. *In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993). Therefore, any doubt as to the existence of a likelihood of confusion must be resolved in favor of the registrant. *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988).

#### **I. THE MARKS ARE NEARLY IDENTICAL**

The marks are compared for similarities in sound, appearance, meaning or connotation. *E.I. du Pont de Nemours* 177 USPQ 563. Similarity in any one of these elements may be sufficient to find a likelihood of confusion. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1536 (TTAB 1988); TMEP §1207.01 (b).

In the present case, applicant is seeking to register the mark TRUWELD and the registrant's mark is TRU-WELD. The marks are highly similar in sound, appearance and commercial impression

because the marks are virtually identical. The only difference between the marks, the additional dash appearing between "TRU" and "WELD" in the registrant's mark, is immaterial in distinguishing the marks or overcoming any likelihood of confusion. Applicant conceded in its appeal brief that the marks are nearly identical. See Applicant's Brief at page 8.

## II. THE GOODS AND THE CHANNELS OF TRADE ARE RELATED

The fact that the goods of the parties differ is not controlling in determining likelihood of confusion. The issue is not likelihood of confusion between particular goods, but likelihood of confusion as to the source of those goods. *In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993), and cases cited therein. Moreover, the goods of the parties need not be directly competitive to find a likelihood of confusion. Instead, they need only be related in some manner, or the conditions surrounding their marketing are such that they would be encountered by the same purchasers under circumstances that would give rise to the mistaken belief that the goods and/or services come from a common source. *On-line Careline Inc. v. America Online Inc.*, 229 F.3d 1080, 56 USPQ2d 1471 (Fed. Cir. 2000); TMEP §1207.01(a)(i).

Where the marks of the respective parties are nearly identical, as they are in this case, the relationship between the goods or services of the respective parties need not be as close to support a finding of likelihood of confusion as might apply where differences exist between the marks. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 877, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992); TMEP §1207.01(a).

Applicant's goods are "industrial machine tools for welding workpieces using a laser beam" and "lasers, not for medical purposes, in particular for the welding and treatment of workpieces." Applicant's goods are for use in laser welding. Laser welding "uses a laser beam to melt and join the work-piece."<sup>[1]</sup> The registrant's goods are "fastening devices including welding studs and shear connectors." Welding studs are used in stud welding. As noted in the evidence of record:

"*Stud welding* is a form of electric arc welding in which the stud itself is the electrode. A stud welding gun holds the stud while the arc is formed and the plate and stud end become molten.

The gun then forces the stud against the plate and the stud is welded to the plate. Shielding is obtained by the use of a ceramic ferrule surrounding the stud.”<sup>[2]</sup>

Laser welding has wide applications. As noted in the excerpt of record from the Automotive.com website at <http://www.automotive.com/features/90/auto-news/20885/index.html>:

“Although the range of applications for laser welding equipment in the production process is already very diverse, there are many more industries that have the potential to benefit considerably from adopting this technology.”

Welding studs also have many applications. As noted by registrant on its website:

“*TRU-WELD* manufactures weld stud fasteners **for a vast variety of applications**. From the small everyday handheld tool or yard machinery to automobiles, aircrafts, bridges, ocean liners & steel structure buildings to military vehicles, weld studs are all around us in our everyday lives.”<sup>[3]</sup> (Emphasis added).

The goods of the parties are related, because both are used in welding applications by the same consumers for manufacturing applications in identical industries. Applicant asserts in its brief that its goods “are utilized in factories and may be used for processing large sheet metal workpieces.” See Applicant’s Appeal Brief at page 6. The excerpt of record from Abante Services shows that laser welding and stud welding are both used in the manufacturing field for welding sheet metal.<sup>[4]</sup> Laser welding and stud welding are also both used in manufacturing automobiles. The excerpt of record from Nelson Stud Welding notes that “[v]irtually all automotive manufacturers worldwide use fasteners and automatic feed or high- speed robotic stud welding systems.”<sup>[5]</sup> The use of laser welding in the automotive industry is also prevalent since laser welding is “gradually replacing traditional forms of welding across many applications in automotive production.”<sup>[6]</sup> Applicant asserts in its brief that its machines “may involve computer operated robots.” See Applicant’s Appeal Brief at page 7. The excerpt of record from Hi-Tech Robotics, Inc. shows that both stud welding and laser welding applications are used in conjunction with robotics.<sup>[7]</sup>

The goods of the parties are also related since the consumers of applicant and registrant’s goods are identical. Stud welding goods and laser welding machines are purchased and used by those providing welding services.<sup>[8]</sup> For example, the materials processing firm Alabama Specialty Products, Inc. advertises specific stud welding equipment and laser welding machines that it uses in providing its welding services. Abante Services advertises the use of laser welding and stud welding in its contract manufacturing involving sheet metal products. Wall Colmonoy Corporation’s Aerobrazo division uses both laser welding and stud welding in providing welding services to the aerospace industry. Consequently, upon encountering nearly identical marks used on stud welding equipment and laser

welding machines for manufacture processes in the same industries, consumers are likely to believe mistakenly that such goods originate from the same source.

Applicant argues that the purchasers of the goods of the parties are sophisticated. However, the fact that purchasers are sophisticated or knowledgeable in a particular field does not necessarily mean that they are sophisticated or knowledgeable in the field of trademarks or immune from source confusion. See *In re Decombe*, 9 USPQ2d 1812 (TTAB 1988); *In re Pellerin Milnor Corp.*, 221 USPQ 558 (TTAB 1983); TMEP §1207.01(d)(vii).

### CONCLUSION

Consumers encountering the applicant's mark and the registered mark in the marketplace are likely to mistakenly believe that the goods emanate from a common source because the marks are identical, and the goods and channels of trade are related. Accordingly, the examining attorney respectfully requests that the Section 2(d) refusal be affirmed.

Respectfully submitted,

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[1] See excerpt of record from the International Labor Organization website at <http://www.ilo.org/encyclopedia/?doc&nd=857200634&nh=0&ssect=2>, attached to Final Office action mailed December 28, 2006.

[2] See excerpt of record from the International Labor Organization website at <http://www.ilo.org/encyclopedia/?doc&nd=857200634&nh=0&ssect=2>, attached to Final Office action mailed December 28, 2006.

[3] See excerpt of record from the TRU-WELD website at <http://www.truweldstudwelding.com/>, attached to applicant's Request for Reconsideration dated June 28, 2007.

[4] See excerpt of record from the Abante Services website at <http://www.abanteservices.com/index.php?lk=62&pid=51>, attached to the Trademark Examining Attorney's denial of applicant's request for reconsideration mailed July 6, 2007.

[5] See excerpt of record from the Nelson Stud Welding website at <http://www.nelsonstud.com/portal/markets/Automotive/tabid/55/Default.aspx>, attached to Final Office action mailed December 28, 2006.

[6] See excerpt of record from the Automotive.Com website at <http://www.automotive.com/features/90/auto-news/20885/index.html>, attached to Final Office action mailed December 28, 2006.

[7] See excerpt of record from the Hi-Tech Robotics, Inc. website at [http://www.hi-techrobotics.com/services\\_robotics.html](http://www.hi-techrobotics.com/services_robotics.html), attached to the Trademark Examining Attorney's denial of applicant's request for reconsideration mailed July, 06, 2007.

[8] Evidence includes excerpts of record from the Abante Services website at <http://www.abanteservices.com/index.php?lk=62&pid=51>, the ABB website at <http://www.abb.com/product/seitp327/6c9e8426dd74dfa3c1257129005485bb.aspx>, the Alabama Specialty Products, Inc. website at <http://www.alspi.com/machinecap.htm>, the Arnold website at [http://www.arnold.de/index.php?en\\_FV\\_s](http://www.arnold.de/index.php?en_FV_s), the Bauer Electronica website at <http://bauer.com.mx/services.htm>, the Ciratec website at <http://ciratec.be/robotservices.html>, the Cirus Laser Limited website at <http://www.cirrus-laser.co.uk/>, the Hi-Tech Robotics, Inc. website at [http://www.hi-techrobotics.com/services\\_robotics.html](http://www.hi-techrobotics.com/services_robotics.html), the Monroeville Industrial Services Company (MISC) website at [http://www.misc-int.com/category\\_details.php?category\\_id=47](http://www.misc-int.com/category_details.php?category_id=47), and the Wall Colmonoy Corporation website at <http://www.wallcolmonoy.com/Locations/cinci.htm>, all attached to the trademark examining attorney's denial of applicant's request for reconsideration mailed July 6, 2007.